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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/211,715	12/14/98	AL-OBEIDI F	P-SE-3243

HM12/0323

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EXAMINER	
MOEZIE,F	
ART UNIT	**PAPER NUMBER**
1653	11

DATE MAILED: 03/23/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/211,715	Applicant(s) AL-OBEIDI
	Examiner F. T. Moezie	Group Art Unit 1653

X Responsive to communication(s) filed on *Jan 24, 2000*

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *three* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

X Claim(s) *1-26* is/are pending in the application.

Of the above, claim(s) *12-26* is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

X Claim(s) *1-11* is/are rejected.

Claim(s) _____ is/are objected to.

X Claims *1-26* are subject to restriction or election requirement.

Application Papers

X See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is ___approved ___disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All ___Some* ___None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

X Notice of References Cited, PTO-892

X Information Disclosure Statement(s), PTO-1449, Paper No(s). *7*

Interview Summary, PTO-413

X Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

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--- ***SEE OFFICE ACTION ON THE FOLLOWING PAGES*** ---

DETAILED ACTION

Applicant's election of Group I invention, claims 1-11, with traverse, filed 24 January 2000, paper no. 9, have been entered. Election of the specie of claim 11 (page 115, line 19) is also acknowledged.

Claims 24-26, drawn to a method for using the claimed peptides, will be considered in a rejoinder upon allowance of the claims to the peptides. The claims were inadvertently missed from the requirement in the earlier Office action.

Remarks regarding the traversal of the requirement have been considered, but not found persuasive. Applicant points out the differences between the two groups of invention on page 2 of the Remarks. It is clear that each invention is distinct from the other and a reference which would render obvious claims of one group of invention would not render obvious claims drawn to the second group of invention. Because the consideration of patentability is different in each case, each invention calls for a separate search. It would be an undue burden to the examiner to search and examine both in inventions in one application.

The restriction requirement is now made FINAL.

CLAIM REJECTION - 35 USC 102 (a) AND/OR (b) AND 35 USC 103 (a)

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-3 are rejected under 35 U.S.C. 102(a) and/or (b) as being anticipated by US patent No. 5,721,214 to Marlowe et al or 5,739,112 to Brunck et al.

Each document teaches peptides containing modified amino acids in their sequence, wherein said peptides exhibit activity against factor Xa. See, especially the claims in each document.

It is noted that the instant application is a CIP of the prior application and applicant has introduced New matter into the specification, therefore the effective filing date for the claims would have to be shown.

Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over the US Patents to Marlowe et al and Brunck et al (cited above).

Each patent discloses modified peptides which exhibit activity against factor Xa. See the entire documents, especially the abstracts and the claims. To use various modified amino acids in the peptides of the reference for their obvious advantage, anti factor Xa activity, would have been within the skill of an ordinary art skilled at the time of the invention.

DOUBLE PATENTING

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim 11 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 39, line 40 of prior U.S. Patent No. 5,849,510. This is a double patenting rejection.

No claim is allowed.

Any inquiry concerning this communication should be directed to Examiner F.T. Moezie at telephone number (703) 305-4508 or Mr. LOW (SPE) at 309-2923.

F. T. Moezie

F. MOEZIE, PH.
PRIMARY EXAMINER
ART UNIT 180
1653